

Serial No.: 10/531,115

REMARKS

This response is timely filed as it is filed within the ONE (1) month shortened statutory period for response to the outstanding Office Action.

Election/Restrictions

The application has been alleged to contain claims directed to the following groups of invention not so linked as to form a single general inventive concept:

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| Group I | Claim 2, drawn to ball elements or ball section elements in ball sockets of an intermediate piece wherein the intermediate piece is seated by a roller, a ball or a sliding bearing; |
| Group II | Claims 12 and 13, drawn to specific facing tracks on guide rails wherein a carriage is guided by revolving rollers or ball units; |
| Group III | Claim 14, drawn to strippers and sealing elements; |
| Group IV | Claims 15 and 16, drawn to specific rail guides cut into a base frame; |
| Group V | Claims 17 and 18, drawn to specific table and gate; |
| Group VI | Claim 19, drawn to a specific passage for an ejector; and |
| Group VII | Claim 20, drawn to a specific measuring pickup of a measuring system. |

The Action has required, under 35 U.S.C. 121, the election of one of the above alleged inventions for prosecution on the merits. The invention of Group I is hereby elected with traverse. Claims readable on the elected invention include Claims 1-11.

Serial No.: 10/531,115

Applicant objects to the use of PCT Rules 13.1 and 13.2 as the basis for the restriction requirement in a U.S. Patent Application. Whereas this Patent Application claims priority to a PCT Application, this is still a U.S. Patent Application, governed by U.S. patent rules.

Claims 12-20 are dependent claims, all depending from generic Claim 1. The basis for this restriction requirement is the Examiner's belief that Claim 1, the base claim, is not patentable. Applicant respectfully asserts that the belief that an independent claim is unpatentable is an improper basis for a restriction requirement among dependent claims, especially where no prior art rejection is formally made. This appears to be a departure from the Patent Office's practice of considering restriction independent of the consideration of particular prior art.

Furthermore, the Office Action does not give details why each Group is "without any unifying novel inventive concept common to all" (or where this standard is found in U.S. Patent Rules). The Office Action simply says that Claim 1, which is a "unifying inventive concept common to all," isn't patentable. The Manual of Patent Examining Procedure (MPEP) in section 808 entitled, "Reasons for Insisting Upon Restriction," specifically provides:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the

Serial No.: 10/531,115

examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

The Office Action has not made a formal prior art rejection to which Applicant can reply. The Office Action also does not provide the reasons why the Groups are considered independent if Claim 1 isn't patentable. Applicant is thus prevented from presenting arguments directed to the merits of the Action's identification of independent and distinct inventions.

In view of the above remarks, reconsideration and withdrawal of this restriction requirement are requested. Applicant reserves the right to present additional arguments if the Examiner maintains the restriction requirement upon providing the necessary reasons for the requirement.

Conclusion

It is believed that the above election with traverse is properly responsive to the requirements contained in the Action and that this Patent Application and all claims are in condition for substantive examination.

Serial No.: 10/531,115

Should the Examiner detect any issue or have any question which might be resolved via a telephone discussion, the Examiner is kindly requested to contact the undersigned by telephone at the (847) 490-1400, in an effort to expedite examination of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Swanson', with a horizontal line extending to the right.

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